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Supreme Court, U.S.
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IN THE

Supreme Court of the United States.

OCTOBER TERM, 1970

No. 697

UNIFLOW MANUFACTURING CO. and
JEFFERSON ICE CO.,
Petitioners,

v.

KING-SEELEY THERMOS CO.,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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QUESTION PRESENTED

The question presented by Petitioners is erroneous in its premise because there is no "recent unanimous holding" by this Court "that a patent on a combination of old elements is valid only if the cooperation of those elements is synergistic." The recent case referred to by Petitioners is

Anderson's-Black Rock, Inc. v. Pavement Salvage Co.[1] In that decision, this Court held the patent in suit invalid because "the use of the old elements in combination was not an invention by the obvious-nonobvious standard." There is no statement in this Court's opinion that a combination patent can be valid only if the cooperation of elements is synergistic and in fact the only reference to "synergistic" in the opinion is the statement, "A combination of elements may result in an effect greater than the sum of the several effects taken separately. No such synergistic result is argued here."

The validity of the patent in suit is not an issue here as Petitioners have conceded that the patent is valid. Under the rules of appellate review the question presented is limited to a determination of whether the trial court's findings of fact that the patent claim in suit literally reads upon the accused device and that the function, operation and results of the patented and accused devices are substantially identical, are clearly erroneous. The Court of Appeals for the Sixth Circuit held these findings of fact were not clearly erroneous.

STATEMENT OF THE CASE

Petitioners in their statement of the case assert that the District Court, without reference to the prior art, concluded that the overall operation of the accused machine was substantially identical to that of the patented machine and that both machines produced substantially identical ice. This statement is not completely accurate.

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[1] 90 S. Ct. 305, 24 L. Ed. 2d 258.

During the trial prior art patents were put in evidence and there was testimony about them. The most pertinent prior art is specifically referred to in the Court of Appeals decision (Petitioners' Appendix 5a). The District Court (Petitioners' Appendix 22a) after considering all of the evidence specifically found as a fact, and after resolving the conflicting testimony of the expert witnesses and from watching demonstrations of the accused and patented machines, that

> "Claim 4 of the patent in suit literally reads on the accused device,"

and that the function and operation of the accused and patented machines

> "are substantially identical and that the ice flakes produced by the machine covered by the patent in suit and the accused device are practically identical in substance and design."

The Court of Appeals in its opinion (Petitioners' Appendix 8a-12a) noted that the District Judge had the benefit of observing the demonstrations of the machines as well as being able to evaluate the testimony of the experts as they explained the operations of the machines. It furthermore noted specific conflicts in the testimony of the experts and held that

> "Findings of fact of a trial judge in a patent case can only be overturned on appeal if the reviewing court finds them to be clearly erroneous. Rule 52(a), Fed. R. Civ. P."

The Court of Appeals affirmed the decision of the District Court regarding validity and infringement because this decision was not clearly erroneous.

ARGUMENT

This Court did not unanimously reaffirm the position that patents covering combinations of old elements are valid only where "synergism" is present in the case of *Anderson's-Black Rock, Inc. v. Pavement Salvage Co. (supra)* for the reasons pointed out previously in this brief under the "Question Presented" section. In that decision this Court did specifically reaffirm the obvious-non-obvious patent validity test of its prior decisions in *Graham v. John Deere Co.*[2] and *Hotchkiss v. Greenwood.*[3]

Furthermore, Claim 4 of the patent in suit here does not cover a combination of old elements but covers a new combination because, as pointed out in the Court of Appeals opinion (Petitioners' Appendix 5a-7a) the invention is the mating of certain prior art elements with a "breakerhead" in the upper end of the freezing cylinder (which was not known before) which

> "for the first time made possible an inexpensive machine that would produce salable flake ice, in sufficient quantities and with enough reliability to be practical commercially."

In any event, Petitioners in their Petition (p. 8) admit that the combination of elements covered by the patent in suit is "synergistic" and the patent is valid. Petitioners however argue that the District Court did not find that the accused machine had this "synergistic" combination of elements and that therefore the District Court did not apply the correct test for patent infringement.

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[2] 383 U.S. 1, 15 L. Ed. 2d 545.

[3] 11 How 248, 13 L. Ed. 683.

This argument is erroneous for two reasons. The District Court rejected Petitioners' contentions respecting "synergistic" differences between the accused machine and the patented machine, and found that the accused machine had all six elements called for in Claim 4 of the patent in suit and that the function and operation of accused machine and the patented machine were substantially identical and that the ice products of both machines were substantially identical (Petitioners' Appendix 22a). Hence, the District Court found the accused and patented machines to be substantially identical from a patent combination standpoint. Therefore, if, as Petitioners admit, the patented machine is "synergistic" the accused machine is equally "synergistic."

Furthermore, the proper test for infringement is the test set forth in this Court's decision in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*[4] In that case this Court said (607)

> "In determining whether an accused device or composition infringes a valid patent resort must be had in the first instance to the words of the claim. If accused matter falls clearly within the Claim, infringement is made out and that is the end of it."

The Court went on in that case to point out that even if the accused matter did not fall clearly within the patent claim, infringement may be made out under the doctrine of equivalents which the Court said is founded on the theory that (608)

> "if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape."

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[4] 339 U.S. 605.

Here the District Court followed both of the foregoing precepts of this Court and found not only literal infringement of Claim 4 of the patent in suit but also found that the patented and accused devices functioned and operated in a substantially identical manner to produce substantially identical ice flakes.

CONCLUSION

Thus, under the settled tests of infringement of this Court, as well as under the Petitioners' proposed "synergistic" test, the accused devices infringe Claim 4 of the patent in suit. The factual findings made by the District Court in resolving the conflicts in the testimony in this case are fully justified by the record, and, not being clearly erroneous, should not be set aside.

Respectfully submitted,

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PETITIONERS' REPLY BRIEF

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PETITIONERS' REPLY BRIEF

Respondent states in its brief in opposition that

> "... the patent in suit here does not cover a combination of old elements but covers a new combination ... which
>
> > 'for the first time made possible an inexpensive machine that would produce saleable flake ice, in sufficient quantities and with enough reliability to be practical commercially.'"

Of course the patent covers a new combination, but it is a new combination of elements each of which taken individually is old.[1] In this respect the combination

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[1] As to respondent's assertion that the "breakerhead" is a new element rather than merely newly combined with the other elements see the Petition for Certiorari p. 11 at n. 29.